

C. APPLICANT'S COMMENTS

Claims 1-3, 5-13, 15-20 are pending in this Application, with Claims 1, 11 being amended and Claims 21-22 being added to further clarify the invention. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-3, 5-13, 15-20 and favorable consideration of Claims 21-22 is respectfully requested. The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 1-2 of the Office Action

The Official Action rejected Claims 1-3, 5-9 under 35 U.S.C. §103(a) as being unpatentable over Foote (U.S. Patent No. 6,109,446) in view of Meksula (U.S. Patent No. 3,713,529). The Applicant has amended independent Claim 1 to include the features of dependent Claim 4 and pursuant to paragraph 5 is now in condition for allowance along with its respective dependent claims. However, the Applicant will address this combination of references as potentially applied to newly added independent Claim 21 which is comprised of the features of original Claims 1, 5 and 6.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish a prima facie case of obviousness, three basic criteria must be met." MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation of success**. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law

which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Newly added independent Claim 21 has the following features:

21. (New) A portable salon station system, comprising:
an enclosure comprised of a base and a cover, wherein said cover is removably connectable to said base;
a support member pivotally attached within said base at a pivot point;
a plurality of holder members attached to said support member;
a guide member pivotally attached within said base; and
a guide slot within said guide member that slidably receives a pin extending from said support member, **wherein said guide slot is curved, and wherein said guide slot has a main portion and an upper catch portion extending substantially transversely with respect to said main portion**, wherein said upper catch portion selectively catches said pin to retain said support member in an upright position.

The Office Action utilizes Meksula to disclose "*a guide member (43) pivotally attached within the base and a guide slot (45) within the guide member that slidably receives a pin (46) extending from the cover.*" (**Office Action, Page 2.**) However, Meksula does not teach the guide slot structure as specifically claimed in independent Claim 21 (see figure below). More particularly, Meksula merely teaches a guide member with a straight guide slot ... nothing more.

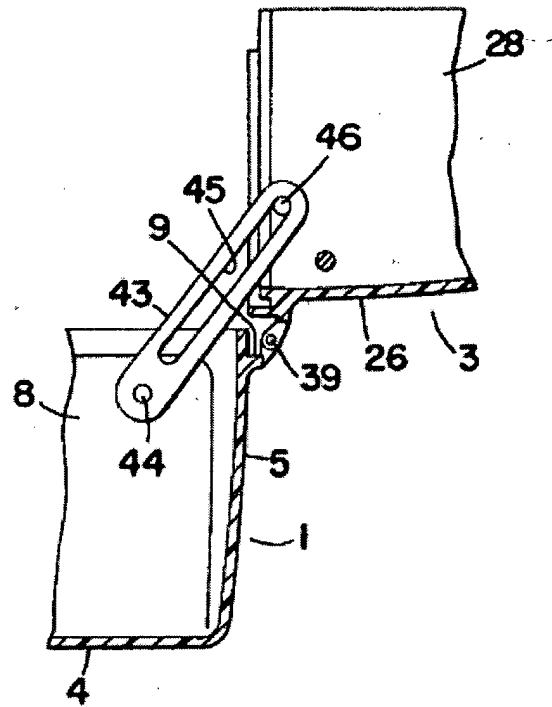


Fig. 8

Figure 8 of U.S. Patent No. 3,713,529 (Meksula)

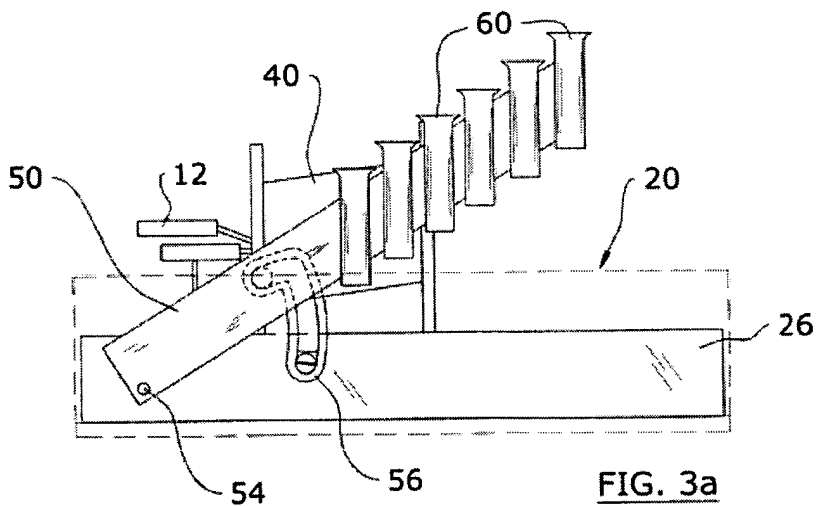


FIG. 3a

Figure 3a of the Present Application

Meksula does not teach “wherein said guide slot is curved.” Meksula does not teach “wherein said guide slot has a main portion and an upper catch portion extending

substantially transversely with respect to said main portion.” Meksula does not teach “*wherein said upper catch portion selectively catches said pin to retain said support member in an upright position.*” These are all features of newly added independent Claim 21 that are not shown in the prior art references (see figures below).

For these reasons, among others, the combination of Foote with Meksula cannot suggest the combination of features in applicant’s Claims 21-22, and it is therefore submitted that any potential rejection against these claims should be reconsidered and 21-22 allowed.

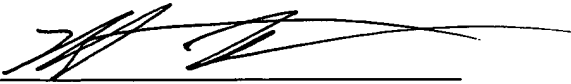
Paragraph 3 of the Office Action

The Official Action rejected Claims 11-13, 15-19 under 35 U.S.C. §103(a) as being unpatentable over Foote (U.S. Patent No. 6,109,446) in view of Meksula (U.S. Patent No. 3,713,529) and further in view of Dunn (U.S. Patent No. 6,294,759). The Applicant has amended independent Claim 11 to include the features of dependent Claim 14 and pursuant to paragraph 5 is now in condition for allowance along with its respective dependent claims.

D. CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully asked that such changes be made by Examiner’s Amendment, if the Examiner feels this would facilitate passage of the case to issuance. Alternatively should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, they are invited to telephone the undersigned.

Respectfully submitted,



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